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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,931	05/19/2006	Johannes Maria Pleunis	NL031365US1	3700

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P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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BASIT, ABDUL

ART UNIT	PAPER NUMBER
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3694

NOTIFICATION DATE	DELIVERY MODE
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08/01/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/579,931	PLEUNIS, JOHANNES MARIA	
	<b>Examiner</b>	<b>Art Unit</b>	
	ABDUL BASIT	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/11 has been entered.

Claims 1-13 are pending. Claims 1-13 were rejected under 35 U.S.C. 112 and 102. Based on the Applicant's amendments, one of the 35 U.S.C. 102 rejections and one of the 35 U.S.C. 112 rejections are withdrawn; however, one 35 U.S.C. 103 and one 35 U.S.C. 112 rejection are not withdrawn. In addition, a new 35 U.S.C. 101 and 112 rejections are given.

### **Response to Applicants Remarks and Amendments**

Applicant assert that the Clark reference does not disclose a “user readable visible indication of data content representing data content in the data store....wherein the computing means....performs user selectable operations in response to said at least one token being spatially presented to the token interfacing means....(i) to read from said at least one token....” Applicant further asserts that Clark does not teach part (ii) of claim 1 which teaches a token being a user readable physical feedback representation in tangible form.

According to the Applicant, Clark teaches an interactive optical disk for recording permanently stored and user supplied information. Thus, according to the Applicant, Clark does not teach user readable visible information and details that are optically readable and further does not teach that the token does not include the data but that such data is stored remotely from the token in the data store.

As discussed, the independent claims are still not definite and the best interpretation is that an optical disk (the token) has data content which teaches the elements of the Applicant's claimed invention.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12 and 13 continue to be indefinite for reciting a token that has data content representing data content in the data store; and then reciting at the end of the claim that the token does not include data content. The Applicant has amended the claims, but the claim amendments do not resolve the issue. The Applicant asserts that the token includes 1) details and 2) identification of the data content. If the token includes details and identification of the data content, then based on the Applicant's own interpretation, the token includes the data content since data is details and identification.

**3. Claims 1-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims include means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

***Claim Rejections - 35 USC § 101***

**3.** 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**4. Claim 13 is** rejected under 35 U.S.C. 101. Based upon consideration of all of the relevant factors with respect to the claim as a whole, these claims are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35

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U.S.C. 101. In light of the recent Supreme Court decision in *Bilski v. Kappos*, 561 U.S. \_\_\_\_ (2010), the *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos* provides factors to consider in determining whether a claim is directed to an abstract idea and is therefore not patent-eligible under 35 U.S.C.

101. Factors weighing toward eligibility include:

- Recitation of a machine or transformation (either express or inherent).
- The claim is directed toward applying a law of nature.
- The claim is more than a mere statement of concept.

Factors weighing against eligibility include:

- No recitation of a machine or transformation (either express or inherent).
- Insufficient recitation of a machine or transformation.
- The claim is not directed to an application of a law of nature.
- The claim is a mere statement of a general concept.

5. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim could positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Furthermore, the use of a particular machine or transformation of a particular article must involve more than insignificant extra-solution activity.

6. In light of the factors in the Supreme Court decision, Applicant's method steps do not meet the requirements of 35 U.S.C. 101. It is unclear whether in claim 13, step (b), the "performing a user-selectable operation" is performed by a machine. Further, step (b) states "in response to said at least one token being spatially." Applicant is requested to clarify whether the requirement that the token must be spatially presented to the token interfacing means?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5-8 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark (US Pat. No. 5,175,720)

**Regarding claim 1:**

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Clark teaches an electronic system for providing visible user physical feedback via at least one data token, comprising:

- (a) computing means; *(see col. 4, lines 5-15 teaching a computer system)*
- (b) a data store coupled to said computing means for at least one of (i) inputting data content to and (ii) outputting data content from the data store; *(see col. 4 lines 5-15 teaching computer system)* and
- (c) token interfacing means coupled to said computing means for interfacing to said at least one data token detachable from the token interfacing means of the system, said at least one token for providing a user readable, visible indication of data content representing data content in the data store *(see col. 2 lines 50-65 teaching a disk that is the token that includes data content)*

wherein the computing means of the system performs user-selectable operations in response to said at least one token being spatially presented to the token interfacing means of the system, the user-selectable operations including at least one of delete, read, write, and rearrange corresponding data content to/from the data store associated with said at least one token (i) to read from said at least one token, using the token interfacing means, details of said data content to identify said data content in the data store and/or (ii) to record on said at least one token, using the token interfacing means, one or more details of said user-selectable operations so that said one or more details include user-readable visible information and details that are optically readable via a user from said at least one token wherein in response to being user-inspected *(see at*



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*least col. 2 lines 50-65, col. 3 lines 1-15, col. 4 lines 5-20 teaching recording and rearranging data such as permanent and temporary recordings)*

said at least one token further being a representation in tangible form of corresponding data content stored in the data store, the at least one token themselves not including the corresponding data content but such data content being stored remotely from the at least one token in the data store. *(see col. 2 lines 60-65 and abstract teaching a tangible product - disk)*

Further, Clark teaches optical technology *(see at least col. 1 lines 10-20 teaching optical technology)*

**Regarding claim 2:**

Clark teaches a system according to claim 1, wherein the token interfacing means is subdivided into spatial sub-regions, each sub-region being associated with a specific type of corresponding user-selectable operation on the data content represented by said at least one token when in response to being presented in spatial proximity of said corresponding sub-region. *(see at least col. 2 lines 60-65 and col. 3 lines 1-15 teaching different sub-regions)*

**Regarding claim 3:**

Clark teaches a system according to claim 1, wherein the token interfacing means is arranged to be capable of handling a pack comprising a plurality of said at least one token and performing said user-selectable\_operation on at least one token in the pack. *(see at least col. 2 lines 60-65 and col. 3 lines 1-15 teaching a disk that can be used)*

**Regarding claim 5:**

Clark teaches a system according to claim 1, wherein said at least one token is provided with:

- (a) a first region susceptible to being user-marked with user optically-readable information; *(see at least col. 2 lines 60-65 and col. 3 lines 1-15 teaches user areas)* and
- (b) a second region susceptible to presenting information optically, said second region being arranged to be written to from the token interfacing means of the system for providing a user optically-readable indication of data content associated with said token. *(see at least col. 2 lines 60-65 and col. 3 lines 1-15 teaches system areas)*

**Regarding claim 6:**

Clark teaches a system according to claim 1, wherein the computing means of the system interrogates, via the token interfacing means, said at least one token when in response to a corresponding at least one token being spatially presented to the token interfacing means of the system, for indicating to the system~ user-preferred data content to be subject to said user-selectable operation. *(see at least col. 2 lines 60-65 and col. 3 lines 1-15 teaching system areas)*

**Regarding claim 7:**

Clark teaches a system according to claim 6, wherein the computing means of the system interrogates, via the token interfacing means, said at least one token is by at least one of: radio interrogation, optical interrogation, contact electrical interrogation,

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and magnetically-coupled electrical interrogation. *(see at least col. 1 lines 1-15)*

**Regarding claim 8:**

Clark teaches a system according to claim 6, wherein said at least one token is provided with a unique identification code for use in enabling the computing means of the system, via the token interfacing means, to identify said at least one token and thereby data content associated with said at least one token. *(see col. 5 lines 7-15)*

**Regarding claim 11:**

Clark teaches a plastic substrate *(see at least col. 3 lines 35-45)*

**Regarding claim 12:**

Clark teaches an electronic system for providing visible user physical feedback via at least one data token, comprising:

(a) computing means; *(see col. 4, lines 5-15 teaching a computer system)*

(b) a data store coupled to said computing means for at least one of (i) inputting data content to and (ii) outputting data content from the data store; *(see col. 4 lines 5-15 teaching computer system)* and

(c) token interfacing means coupled to said computing means for interfacing to said at least one data token detachable from the token interfacing means of the system, said at least one token for providing a user readable, visible indication of data content representing data content in the data store *(see col. 2 lines 50-65 teaching a disk that is the token that includes data content)*

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wherein the computing means of the system performs user-selectable operations in response to said at least one token being spatially presented to the token interfacing means of the system, the user-selectable operations including at least one of delete, read, write, and rearrange corresponding data content to/from the data store associated with said at least one token (i) to read from said at least one token, using the token interfacing means, details of said data content to identify said data content in the data store and/or (ii) to record on said at least one token, using the token interfacing means, one or more details of said user-selectable operations so that said one or more details include user-readable visible information and details that are optically readable via a user from said at least one token wherein in response to being user-inspected (*see at least col. 2 lines 50-65, col. 3 lines 1-15, col. 4 lines 5-20 teaching recording and rearranging data such as permanent and temporary recordings*)

said at least one token further being a representation in tangible form of corresponding data content stored in the data store, the at least one token themselves not including the corresponding data content but such data content being stored remotely from the at least one token in the data store. (*see col. 2 lines 60-65 and abstract teaching a tangible product - disk*)

Further, Clark teaches optical technology (*see at least col. 1 lines 10-20 teaching optical technology*)

9. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Clark (US Pat. No. 5,175,720)

**Regarding claim 13:**

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Clark teaches a method for providing visible user physical

feedback via at least one data token, comprising:

a) providing the system with computing means, a data store coupled to said computing means for at least one of (i) inputting data content to and (ii) outputting data content from the data store, and token interfacing means coupled to said computing means for interfacing to at least one data token detachable from the token interfacing means of the system, said at least one token for providing an intuitive a user-readable, visible indication of data content representing data content in the data store; and *(see col. 2 lines 50-65 teaching a disk that is the token that includes data content and see col. 4 lines 5-15 teaching computer system)*

(b) performing a user-selectable operation in response to said at least one token being spatially presented to the token interfacing means of the system, the user-selectable operation including at least one of deleting, reading, writing, and rearranging corresponding data content to/from the data store associated with said at least one token, arranging for the system (i) to read from said at least one token, using the token interfacing means, details of said data content to identify said data content in the data store and/or (ii) to record on said at least one token, using the token interfacing means, one or more details of said user-selectable operation so that said one or more details include user-readable visible information and details that are optically readable via the user from said at least one token in response to being user-inspected, said at least one token further being a visible, user-readable, physical feedback representation in tangible form of the corresponding data content stored in the data store, the at least one token

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themselves not including the corresponding data content but such data content being stored remotely from the at least one token in the data store. *(see at least col. 2 lines 50-65, col. 3 lines 1-15, col. 4 lines 5-20 teaching recording and rearranging data such as permanent and temporary recordings; see col. 2 lines 60-65 and abstract teaching a tangible product – disk, and see at least col. 1 lines 10-20 teaching optical technology)*

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Selinfreund (US Pat. Pub. No. 20050050343)

#### **Regarding claim 4:**

Selinfreund, not Clark, teaches a system according to Claim 1, wherein the computing means prevents said data content from being subject to at least a subset of said user selectable operations in response to a corresponding token being spatially remote from the token interfacing means. *(see paragraph 10 – prevents reading data, paragraph 5 – device has to have a specific signal for reading)*

It would have been obvious to one of ordinary skill in the art to try to implement security measures as to prevent data from being read if it is not being read by a specified

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device.

**Regarding claim 9:**

Selinfreund, not Clark, teaches a system according to Claim 1, wherein said at least one token is provided with at least one corresponding region which is susceptible to being electronically programmed by the system to present visual information provided from the system, said visual information being related to data content associated with said at least one token. as opposed to bearing the actual data content. *(see at least Fig. 1 teaching a visual display of the related data content)*

It would have been obvious to one of ordinary skill in the art to use a disk to display data that has visual information associated with it and is visible on a display.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Selinfreund and in further view of Pan (US Pat. No. 6,707,479).

**Regarding claim 10:**

Pan, not Clark, teaches a system according to Claim 9, wherein said at least one region is provided with electrically-writable ink for use in providing user-readable visual information of data content associated with said at least one token. *(see at least abstract)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to use electrically writeable ink since this methods allows for identification of the token and the data associated with the token.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABDUL BASIT whose telephone number is 571-272-5506. The examiner works a flexible schedule and can normally be reached during the week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ABDUL BASIT/  
Examiner, Art Unit 3694

/Elizabeth H Rosen/  
Primary Examiner, Art Unit 3694